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In re **PATENT APPLICATION** of
Inventor(s): Mills

Group Art Unit: 1745

Appln. No.: 09/009,294

Examiner: Kalafut

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Filing Date: 1/20/1998

NOV 19 2001

Title: HYDRIDE COMPOUNDS

GROUP 1700

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT Application of Mills

Group Art Unit: 1745

Application No. 09/009,294

Examiner: Kalafut

Filed: January 20, 1998

For: HYDRIDE COMPOUNDS

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November 19, 2001

**REQUEST FOR RECONSIDERATION
OF DECISION ON PETITION**

Director Jacqueline M. Stone
Technology Center 1700
United States Patent and Trademark Office
Washington, D.C. 20231

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GROUP 1700

Director Stone:

Applicant kindly requests reconsideration of the Decision on Petition (Paper No. 37) denying Applicant's request to withdraw the finality of the Office Action mailed July 3, 2001.

I. Introduction

The PTO, through its Decision, effectively punishes Applicant for merely having requested a full and fair consideration of experimental data and other technical evidence that had been of record for almost 4 years in this case. The "Secret Committee," which is now prosecuting the subject application, for the first time took a position on that evidence in a Final Rejection, contrary to PTO rules, in what appears to be yet another attempt to subvert Applicant's technology.¹

The Decision, however, completely ignores these and other relevant facts, thus

¹ Applicant's March 1, 2001 response in this case provides background as to the genesis of the "Secret Committee" and some of the other unfair procedures that have been invoked against Applicant in prosecuting this and other BlackLight applications.

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failing to even respond to the grounds on which Applicant's Petition was based. Instead, it merely maintains that the Final Rejection is based on the same statutory grounds and the same reasoning as the first Office Action, and responds to other evidence and arguments submitted by Applicant that have no bearing on whether the finality of that rejection was premature. As such, the Decision should be withdrawn and the Petition granted for the reasons set forth therein and as further explained below.

II. Applicant's Petition Made A Compelling Case for
Withdrawing the Finality of the July 3 Office Action

Applicant's Petition lays out in considerable detail the factual and legal bases for withdrawing the premature finality of the July 3 Office Action, as it introduced new substantive grounds of rejection that were neither necessitated by amendment of the claims, nor based on information submitted in an information disclosure statement. Because the Decision fails to even acknowledge the underlying relevant facts that inextricably lead to that conclusion, let alone consider them, a brief summary of those facts is in order.

As noted in Applicant's Petition, Examiner Kalafut thoroughly reviewed the scientific evidence of record and, based on that review, found this application to be in condition for allowance. Following the controversial withdrawal of this application from issuance, the PTO, through its "Secret Committee," issued a first Office Action, dated September 1, 2000, rejecting all claims under 35 U.S.C. §§ 101 and 112.² Applicant's Response, dated March 1, 2001, noted several deficiencies in that Office Action without amending the claims, particularly the Secret Committee's failure to consider the scientific evidence already made of record and its failure to adequately address supposed shortcomings in Applicant's theory underlying his claimed invention.

² The withdrawal of BlackLight's applications from issue resulted in District Court litigation, which case is pending on appeal at the Federal Circuit. [*BlackLight Power, Inc. v. Q. Todd Dickinson*, No. 00-1530]

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The Petition further noted the Secret Committee's attempt—unsuccessful though it was—to overcome those deficiencies in its July 3 Final Office Action. Applicant provided specific examples demonstrating how, in that action, the Committee unfairly raised new substantive grounds of rejection by addressing for the very first time record evidence and other previously submitted technical information that should have been addressed in its first Office Action. Applicant further cited numerous examples of new state-of-the-art books and journals that were relied upon by the Secret Committee and newly-minted arguments that also could have and should have been presented earlier so as to develop a clear issue prior to appeal.

For these and other reasons more fully developed in the Petition, Applicant argued that the finality of the July 3 Office Action was premature and should be withdrawn.

III. The Decision Completely Ignores Relevant Facts and Fails to Respond to the Grounds on Which Applicant's Petition was Based

Incredibly, the Decision does not so much as mention a single relevant fact that formed the basis for Applicant's Petition.³ Rather, the Decision conveniently ignores these facts in arguing that the Final Rejection was proper because it was based on the same statutory grounds as the first Office Action:

In the instant case, no new ground of rejection was applied by the examiner in the final office action. The 35 USC 101 and 112, first paragraph rejections were the same as those in the previous non-final action. . . . [Decision at 2]

That argument, however, is nonsensical and misinterprets the PTO's procedural guidelines on this issue, found in MPEP § 706.07(a), which provide in pertinent part:

³ Inasmuch as the PTO is not disputing any of these facts, they must be accepted as true.

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Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement. [Emphasis added.]

The problem with the Decision is that it improperly equates the introduction of a "new ground of rejection" with the raising of a new statutory basis for rejection. That is not the correct standard to be applied in considering whether an Office Action was prematurely made final. The Decision compounds this error by completely ignoring Applicant's Petition arguments showing that the Final Office Action introduced new substantive grounds of rejection under the same statutory provisions, i.e., Sections 101 and 112.

As the PTO well knows, a "new ground of rejection," as referred to in Section 706.07(a), does not require that a new statutory basis be raised. Indeed, the MPEP recognizes situations in which a subsequent Office Action raising a new substantive basis for a rejection, even under precisely the same statutory provision as a prior Office Action, must be made non-final. For example, a second Office Action introducing a rejection under 35 U.S.C. § 103 based upon newly cited art, not necessitated by amendment, would not be made final simply because the claims were previously rejected under that same statutory basis for obviousness. [MPEP § 706.07(a)]

Rejections issued under Sections 101 and 112 are no different and, therefore, should be afforded the same treatment. The PTO's refusal to even consider this aspect of Applicant's Petition is just another example of the arbitrary and capricious way it has handled this case and related applications.

In what seems a desperate grasping at straws, the Decision refers to the fact that the examiner [in actuality the Secret Committee] "specifically referred back to [the] non-final Office action for the reasoning behind the rejections." [Decision at 1.] While that may be technically true, it does not change the fact that additional reasoning was provided as a basis for the final rejection of claims. More significantly, those reasons

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The Decision's failure to even address the relevant facts presented as the basis for Applicant's Petition is but another example of the PTO's reluctance to provide such a full and fair hearing.

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IV. Conclusion

Based on the foregoing reasons, the Decision on Petition should be reconsidered and modified to grant Applicant's request that the finality of the July 3 Office Action be withdrawn as premature.

Respectfully submitted,
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